



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/341,287 08/19/99 WOODS

J LC-302/PCT/U

EXAMINER

IM52/0306

Loctite Corporation
Legal Department
1001 Trout Brook Crossing
Rocky Hill CT 06067

WILSON, D

ART UNIT

PAPER NUMBER

1713

DATE MAILED:

03/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application N . 09/341,287 | Applicant(s) WOODS ET AL. | |
| | Examiner D. R. Wilson | Art Unit 1713 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2000.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6,7,10,11 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-9 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____ |

Art Unit: 1713

DETAILED ACTION

Response to Restriction/Election of Species Requirement

1. Applicant's election of the inventions of Group I, now Claims 1-15 and 19-20, and the species of as exemplified in Example 1, i.e., (a) a carboxylic acid -terminated butadiene acrylonitrile copolymer, (b) ethylene carbonate as the hydroxylating agent, (c) tetraethylammonium iodide as the phase transfer catalyst, and (d) no amphoteric agent present, in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. The requirement is still deemed proper and is therefore made FINAL. Claims 16-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Claims 6-7, 10-11 and 19-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected specie of the invention.

Response to the Amendment

3. Applicant's amendment filed 11-28-00, has been fully considered with the following results.
4. The amendment overcomes the rejection under 35 U.S.C. § 112, second paragraph, concerning, (i) lack of antecedent basis for using combinations of hydroxyalkylating agents, and (ii) the ratio of reagent in Claim 14, and in this regard the rejection is withdrawn. However, the amendment is not deemed to be persuasive in overcoming the other bases of rejection under 35 U.S.C. § 112, second paragraph, which are maintained as is discussed below.
5. The amendment is not deemed to be persuasive in overcoming the prior art rejection which is maintained for the reasons discussed below.

Previously Cited Statutes

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Objection to New Matter

7. The amendment filed 11/28/00 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the

Art Unit: 1713

disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant has provided no basis in the specification as filed for the amendment to Claim 14, i.e., a molar ratio of alkylating agent to acid-functionalized material of about 4 to about 5.

Each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment along with any additional comments on page(s) separate from the page(s) containing the amendment. 37 CFR 1.121 (b)(2)(iii)

The general statement that "--- support for which is replete throughout the specification, such as the examples section", does not fulfill applicant's obligation. It is not up to the Examiner to have to hunt through the specification to find the necessary support.

8. Applicant is required to either provide the specific basis for the support or to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112, First Paragraph

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 14 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter in question is that discussed in the preceding section.

35 U.S.C. § 112, Second Paragraph, Rejection

11. Claims 1-5, 8-9 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The languages of Claims 1 and 8 are indefinite because the meaning of "c", "t", "v" and "a" is not clear. The basis of this rejection was stated in Detailed Action § 10(a) of the previous Office Action. Applicant's explanation that those persons of ordinary skill in the art will readily recognize that in structural formula the letter designations represent mole fractions including the

Art Unit: 1713

values of 0 is not deemed to be persuasive because it is not supported by any evidence.

Applicant also has not amended the claims to provide this meaning and has applicant pointed to support in the specification as filed from which this meaning can be inferred.

b. Claims 2 and 9 are indefinite because Claims 1 and 8 provide no antecedent basis for using combinations of carboxylic acid-functionalized polymers. The basis of this rejection was stated in Detailed Action § 10(b). Applicant has not responded to this aspect of the rejection

35 U.S.C. § 103(a) Rejection

12. Claims 1-5, 8-9 and 12-15¹ are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto in view of Examiner's Notice, in further view of Wu or Yoshino.

13. Applicant traverses the added teachings of Wu and Yoshino pointing out their individual deficiencies as opposed to the teachings relied upon in the rejection. Wu and Yoshino were relied upon only for their teachings of alternative methods to using ethylene oxide for hydroxyalkylating carboxylic acids.

Applicant cannot show non-obviousness by attacking the reference individually where, as here, the rejection is based on a combination of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

Obviously, if Wu or Yoshino taught applicants polymers they would be anticipatory references by themselves. If applicant's criteria for an obviousness rejection were necessary, there would be no obviousness rejections.

14. The argument that the references don't teach that they should be combined is also not deemed to be persuasive. The issue is not whether Reference A and B specifically teach that they should be combined. The issue is whether one of ordinary skill in the art, confronted with the combined teachings of References A and B would have found their combination obvious.

If it can be logically deduced that the reference will imply something to one of ordinary skill in the art that the reference does not come right out and say, then logical reasoning will make that reference evidence for its implicit disclosure, as well as for its explicit disclosure. "In considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonable be expected to draw therefrom." *In re Preda*, 159 USPQ 342 (CCPA, 1968).

¹ The Examiner thanks applicant for pointing out and understanding the typographical error of the specified claims in the stated rejection of the previous Office Action.

Art Unit: 1713

In the instant rejection it is believed that one of ordinary skill in the art, confronted with the references, would clearly be motivated to combine the teachings in the manner set forth by the Examiner in the stated rejection.

15. If applicant is arguing that the references are non-analogous art, this is also not deemed to be persuasive.

The determination that a reference is from a non-analogous art is twofold. First, it is decided if the reference is within the field of the inventor's endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174; *In re Clay*, 23 USPQ.2d 1058.

In the instant it is believed that art involving the carboxylic acid hydroxyalkylation of polymers is within the field of endeavor of applicant, and even if not, the added references are clearly reasonably pertinent to the particular problem with which the inventor was involved.

16. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Examiner believes that only knowledge which was within the level of ordinary skill at the time the claimed invention was made has been relied upon, and does not include knowledge gleaned only from the applicant's disclosure.

Action Is Final

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1713

19. This application contains claims 6, 10-11 and 16-20 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-892-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351

A handwritten signature in black ink, appearing to read 'DR Wilson', with a long horizontal flourish extending to the right.

D. R Wilson
Primary Examiner
Art Unit 1713